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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91161373
Party	Plaintiff American Italian Pasta Company
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Attachments	Response to Reply.pdf (4 pages)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AMERICAN ITALIAN PASTA COMPANY)	
)	
Opposer,)	
)	Opposition No. 91161373
v.)	
)	Mark: BARILLA - AMERICA'S
)	FAVORITE PASTA
)	
BARILLA G.E.R. Fratelli Societa Per)	Application No. 78/136,703
Azioni)	
Applicant.)	Published: March 23, 2004

**OPPOSER'S RESPONSE TO REPLY IN FURTHER SUPPORT OF
MOTION FOR EXTENSION OF TIME**

Opposer respectfully submits this brief Response in order to address the assertions made by Applicant's counsel in regard to the subject Motion for Extension of Time to extend discovery by two days to November 3, 2005 - two days after the close of discovery. The overheated rhetoric reflects an unfortunate trend to "try the lawyer" instead of the facts, and to divert the attention of the Board from the fact that Applicant consciously sought an extension without consulting opposing counsel in order to obtain a unilateral litigation advantage.

To correct the allegation that Opposer has sought to avoid or delay discovery which would thereby form a basis for the requested extension, it should be noted that Opposer timely served its discovery responses to the first set of discovery on Applicant on October 14, 2004. By working through cooperation with earlier counsel, Mr. Cameron, an agreement was reached on the production of documents, which were voluminous. The production of documents on a CD-Rom is reflected in that agreement. The delay in production was, thus, a matter of agreement, rather than a unilateral delay. Opposer

assertion of the “necessity” of the discovery is novel, as is the placement at the doorstep of Opposer and the assertion of fault. Discovery is an option, not always pursued. The choice to pursue some discovery on the day of close, and not other discovery, is counsel’s election, not the fault of Opposer. The same is true with regard to the assertion that the additional discovery was served in order to avoid burdening the Board with a motion to compel. Subsequent to the filing of the Motion for Extension, the threat has re-emerged, which Opposer stands ready to address, if need be. Thus, it is highly questionable that the late discovery was a sacrifice Applicant made for the good of the Board.

As to Opposer’s desire for additional discovery, the two-day extension (without notice) was calculated to thwart that possibility. Opposer did, in fact, desire additional discovery upon receipt of the Answer to the Amended Notice of Opposition, and thus consented to only a two-week delay. However, the Board granted even more time, and Applicant has now tactically exploited that timing so that the Answer was received by mail only after the two-day extension expired.

Yes, it is true that the answering of repeated requests for production of documents, interrogatories and requests for admission are expensive and burdensome, and which expensive tasking Opposer would like to avoid. But the answering of the requests is much more burdensome than the making of the discovery requests. Applicant simply chose to unilaterally request an extension to gain an unfair litigation advantage.

The Board should deny the Motion as untimely and unnecessary so that the parties in an Opposition proceeding do not unfairly exploit the process. However, if the Board decides to grant an extension, it should do so in a manner where both sides are on notice and treated equally, and reset the discovery and testimony periods.

continued to supplement its responses as discovery became available. In contrast to the over 5000 documents produced by Opposer in the Spring of 2005, Applicant delayed its responses for over three additional months (due October 14, 2004, mailed January 28, 2004). A total of 27 pages of documents have been produced.

Still, when current counsel called to request an initial extension of time, Opposer voluntarily informed her of pending motions and additional discovery. The request for an extension of discovery was made before this information was communicated, and Opposer's counsel not only agreed first, but volunteered the information about the Motion to Amend the Notice of Opposition and the serving of additional discovery thereafter. Thus, the consented-to Motion for an Extension filed on May 9 is in no way attributable to the Motion to Amend or any delay by Opposer.

The assertion that no one else was available to work on this case is indeed a novelty. While the undersigned was advised on May 6 that Ms. Calcagno had assumed responsibility for the case, it was not indicated that Mr. Cameron had left the firm. Certainly Mr. Cameron had signed the applications in issue, and Mr. Rothwell spoke to the undersigned (who consented to the requested extension) and signed the Answer. Opposer does not wish to discriminate on the basis of age, nor on the asserted specialties. Opposer's principal counsel also is engaged in patent practice, but presumably this does not disqualify him from the ability to act in this proceeding.

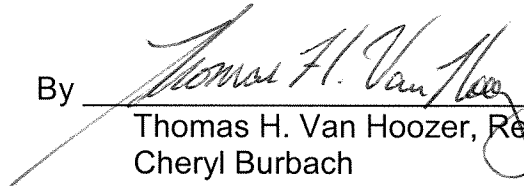
Applicant's asserted injury did not prevent her from serving voluminous discovery on Opposer in a timely manner on the day of close of discovery, as previously indicated. Thus, there should not now be a unilateral grant of a two-day extension when any injury obviously did not prevent Opposer or others from working on the case. Moreover, the

The Board has repeatedly encouraged opposing counsel to work together in these matters. Opposer has granted **four requests for extension** when asked in advance, and has produced thousands of documents to Applicant's 27 pages. The type of tactic employed here, to make a request that would not be received by opposing counsel until after the requested extension expired, is not one in which equity favors the movant.

Accordingly, Opposer respectfully requests that the Motion for Extension of Time be denied.

Respectfully submitted,
HOVEY WILLIAMS LLP

By

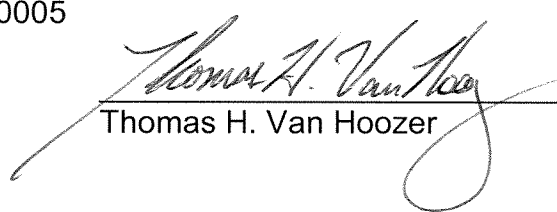

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Opposer's Response to Reply in further Support of Motion for Extension of Time was mailed this 12th day of December, 2005 by first class mail, postage prepaid, addressed to the attorney for Applicant at the following address:

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